
IN THE
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

William I. Bettis and Patterson-
Ballagh Corporation, a corporation,
Appellants,

vs.

Paragon Rubber Products Company,
a corporation; California Manufac-
turing & Engineering Company, a
corporation; B. F. Goodrich Com-
pany, a corporation, and Rotary
Supply Company, a corporation,
Appellees

APPELLEE'S BRIEF.

FORD W. HARRIS,
HERBERT A. HUEBNER,

*Counsel for Defendant-Appellee, California Manufactur-
ing & Engineering Company.*

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No. 6035.

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APPELLEE'S BRIEF.

OPENING STATEMENT.

We think the defendant's position can best be defined by formal statement of each point of our argument followed by a brief discussion of the facts and law supporting that point.

We have not attempted in this brief to follow the arrangement of appellant's brief, nor to reply *seriatim* to all of the many issues raised therein, contenting ourselves with as brief and direct an exposition of our

case as we are able to produce. The fact that we do not seriously discuss all the multitudinous statements made in and issues raised by appellant's brief should not be construed as an admission on our part that we agree with appellant's position thereon but merely that we consider many of these points unimportant or not determinative of any issue in this case.

We have also refrained from a voluminous citation of patent law since we feel that no abstruse legal questions are involved and that the multiplication of citations on well established points of law could be of no possible assistance to the court.

We think our position will be quite plain to the court after a consideration of the following argument.

ARGUMENT.

POINT I.

The Bettis Patent, Plaintiff's Exhibit 1, the Drawing of Which Is Reproduced at the End of This Brief, Is Invalid on Its Face Because:

(a) There is no invention in putting rubber between moving parts for the purpose of reducing shocks and wear in view of the common use of rubber for this purpose in rubber heels, rubber tires and the like, all of which are subject to judicial notice.

(b) Rings of rubber are extremely old. All that Bettis has done is to put such an old ring on a drill pipe. It is not invention to use an old process, machine, composition of matter, or design for a *new* and analogous purpose.

Lettelier v. Mann, (S. D. Cal., 1899) 91 Fed. 914;
Browning v. Colorado Telephone Co., (C. C. A.,
8th Cir., 1894) 61 Fed. 845;
Mast, Foos & Co. v. Stover Mfg. Co., 44 L. Ed.
856, 860, 177 U. S. 485 (1900).

The rubber of Bettis functions for Bettis just as rubber has functioned for others for nearly a hundred years. It is not even used for a *new* purpose by Bettis.

POINT II.

There Is No Invention in Depending Upon the Resiliency of a Rubber Ring to Hold It in Place Because:

(a) *Every* rubber ring has the inherent quality of gripping the body of a device upon which it is sprung if that body is slightly larger in diameter than the hole in the rubber.

(b) In the “Rubber Tip Pencil Case” the Supreme Court 56 years ago held that it was perfectly obvious, if the hole in the rubber were made smaller than the cylindrical body upon which it was placed that it would grip the cylindrical body when placed thereon.

In *Rubber Tip Pencil Co. v. Samuel E. Howard, et al.*, 87 U. S., 20 Wall. 498, 22 L. Ed. 410, Mr. Chief Justice Waite said:

“Any piece of rubber with a hole in it is all that is required thus far to meet the calls of the specifications, and thus far there is nothing new, therefore, in the invention. Both the outside and inside may be made of any form which will accommodate the parties desiring the use.

“But the cavity must be made smaller than the pencil and so constructed as to encompass its sides and be held thereon by the inherent elasticity of the rubber. THIS ADDS NOTHING TO THE PATENTABLE CHARACTER OF THE INVENTION. Everybody knew, when the patent was applied for, that if a solid substance was inserted into a cavity in a piece of rubber smaller than itself, the rubber would cling to it. The small opening in the piece of rubber, not limited in form or shape, was not patentable; neither was the elasticity of the rubber.”

POINT III.

The Fact That a Device Has Gone Into Extensive Use Is Not Necessarily Evidence of Invention, Because:

(a) This wide commercial use may be and “is often due to business ability in manufacturing, exploiting and advertising, and to the fact that prior conditions have not stimulated development”.

Hyde v. Minerals Separation, Ltd., et al., 214 Fed. 100, C. C. A., 9th Cir. (1914);

Olin v. Timken, (1894) 155 U. S. 141, 155, 15 Sup. Ct. 49, 55, 39 L. Ed. 100;

McClain v. Ortmyer, (1891) 141 U. S. 419, 428, 12 Sup. Ct. 76, 79, 35 L. Ed. 800.

(b) This court in the past has many times had this argument presented to it and has repeatedly rejected it, following the practice of the Supreme Court and the other Circuit Courts of Appeal.

American Sales Book Co., et al. v. Bullivont, 117 Fed. 255, at 259, C. C. A., 9th Cir. (1902);

Klein v. City of Seattle, 77 Fed. 200, at 204, C. C. A., 9th Cir. (1896).

POINT IV.

If the Bettis Patent Is Not Invalid per se, It Is Invalid in View of the Prior Art Cited in This Case, Because:

(a) The Wellington patent, Defendant's Exhibit W, the drawings of which are reproduced at the end of this brief, shows rubber placed on a rotating shaft in a well to reduce friction and protect the casing.

The drill pipe of Bettis is a *shaft* that is rotating and transmitting power. In both Wellington and Bettis power is applied to the shaft at the surface of the ground, the power is transmitted by the shaft through the casing to a point near the bottom of the well where it drives a pump in Wellington and a bit in Bettis.

The Sherwood patent, Defendant's Exhibit X, shows water lubricated rubber members carried on a shaft.

The rubber members of Wellington are designed to protect both the shaft and the casing against wear by abrasion and impact.

It should be noted that neither the Wellington nor Sherwood patents, Defendant's Exhibits W and X, respectively, were found or cited by the Patent Office during the prosecution of the Bettis application and that the Bettis patent issued without any comparison by the Patent Office of the subject matter of these patents with the subject matter of the Bettis application.

The other features of the disclosure of the Bettis patent are anticipated by the patents of the prior art. A bumper is disclosed in Shelley patent, Exhibit O, Conrader patent,

Exhibit Q, Izer patent, Exhibit R, and Gunn patent, Exhibit T. A bumper is disclosed as made of rubber in Vogelsong patent, Exhibit P, and as fixed to the pipe in Shelley patent, Exhibit O, Vogelsong patent, Exhibit P, Izer patent, Exhibit R, and Wigle patent, Exhibit S. The use of such a bumper is disclosed with the rod of a rock drill in Shelley patent, Exhibit O, with a piston rod in Wigle patent, Exhibit S, and with pump rods in Vogelsong patent, Exhibit P, Conrader patent, Exhibit Q, and Izer patent, Exhibit R.

There is, in the light of the prior art, no novelty in providing a bumper for a shaft rotating in a well, or making it of rubber, or fixedly attaching it to the shaft.

(b) Every claim *now* in the case, and every claim that *has ever been* in the case as shown by the file wrapper Plaintiff's Exhibit 1, is limited to a ring of resilient material gripping (or adapted to grip) the pipe. Since applicant never *attempted* to assert a greater novelty before the Patent Office, patentee is obviously estopped from asserting a broader novelty here.

(c) Appellant apparently does not now seriously urge that Bettis is entitled to any credit for discovering the friction reducing qualities of wet rubber. This is of course wise since every wearer of rubber heels knows that wet rubber slips easily and the Sherwood patents in evidence in this case show and claim water lubricated bearings of rubber. In other words, the idea that wet rubber slips easily was not original with Bettis.

POINT V.

The Only Novelty That Can Possibly Be Claimed by Bettis Is That Defined by Bettis in His Claims, Namely, a Resilient Ring Gripping the Pipe by Its Resiliency, as in Claims 2 and 5, and the Novelty Defined in Claim 2, Namely, that the Resilient Ring Is “Adapted to be Sprung Over a Tool Joint.” This Alleged Novelty Is Not Novelty in Fact, Because:

(a) Both the Wellington patent, Fig. 5, Defendant’s Exhibit W, and the Sherwood patent, Defendant’s Exhibit V, show rubber members gripping the shaft and *adapted* by their natural or inherent resiliency to be *sprung* over a collar or any other enlargement of the shaft.

POINT VI.

Even If the Court Were to Hold That It Was Novel for Bettis to Provide a Rubber Member Gripping the Pipe by Its Resiliency, It Must Still Hold the Bettis Patent Invalid Since the Use of the Natural Tendency of a Ring of Rubber to Grip a Member on Which It Is Stretched Does not Constitute Invention, Because:

(a) The Supreme Court so held in the “Rubber Tip Pencil” case. If it was not invention to do this in 1874 when the “Rubber Tip Pencil” case was decided, it is certainly not invention now due to the enormous use that has been made of rubber since that time.

POINT VII.

We Did Not Strenuously Urge the Invalidity of the Bettis Patent in the Court Below Because:

(a) We were quite sure we did not infringe, since defendant has not made rings of resilient rubber *gripping* the pipe, nor is defendant's device adapted to be "*sprung* over a tool joint".

(b) If the Bettis patent is held valid but not infringed it tends to eliminate the competition of other rubber rings gripping the pipe, and hence our client who does not infringe the Bettis patent is slightly benefited if it is left in full force and effect.

POINT VIII.

We Are Not Strenuously Urging the Invalidity of the Bettis Patent Before This Court for the Reasons That Applied in the Court Below, but We Feel the Court Should Carefully Consider This Point Because:

(a) If the Bettis patent is invalid the court may consider it its duty to declare it invalid and thus prevent further litigation thereon.

POINT IX.

We Are Strenuously Contending That the Bettis Patent Is Not Infringed by Our Client's Device Because:

(a) The court below after a very careful consideration of the case so held and we believe this court will sustain the court below unless error is clear.

(b) The claims of the Bettis patent considered in view of the prior art do not read upon our client's device since:

(aa) Our client's device, Defendant's Exhibit G, illustrations of which are included at the end of this brief, has no ring of resilient material as it uses a *metal* ring which is without *resiliency*, in the plain meaning of the word, as used in the Bettis patent. Our client has rubber inserted in and carried by the metal ring but the resiliency of this rubber has nothing to do with gripping the pipe. The attempt of counsel to argue that metal has *some* slight resiliency is a plain perversion of language. The drill pipe and casing have the same degree of resiliency as our metal ring and yet the main purpose of the Bettis patent is to provide means for cushioning their impact. When Bettis speaks of *resiliency* he means *resiliency*, that is resiliency sufficient to allow the ring to be *sprung* over a collar, to cushion the blow, and to *grip* the pipe. Our client's metal ring has no such resiliency. The argument of appellant's counsel that the high degree of resiliency of rubber is an *unessential* function is contradicted by the plain wording and intent of the Bettis patent. This high resiliency is not only *necessary* but *indispensable* to the successful operation of the Bettis invention.

(bb) Our client's ring does not grip the pipe but is free to slide up and down thereon as far as the ring itself is concerned. To prevent slipping on the pipe we use mechanical locking means, *i. e.*, the slips, just as Wellington, Defendant's Exhibit W, for example, uses metal flanges.

(cc) Our client's device shows a *superior* method of locking the protector against movement over that disclosed

by Bettis in that when the slips are wedged in place the protector is rigidly locked and *cannot* slip lengthwise of the pipe and hence our protectors stay where they are put, which is something that is not true of the Bettis protectors.

(dd) Our client's device is certainly not adapted to be *sprung* over a tool joint or collar. It is placed upon the pipe by removing one of the pins and opening one side of the device. With the pins in place it will not pass over the tool joint or collar. Our method of placing the protector on the pipe is not merely *different* from that used by Bettis, it is a *better* method. Appellant urges that our device *could* be *passed* over a collar when open. Obviously, this would be an idle act in which no sane person would indulge. Moreover, the fact that we could open our client's device and *pass* it over a collar does not mean that our device is adapted to be *sprung* over a collar.

(ee) Any interpretation of the claims of the Bettis patent which would hold that our client's device infringes would also with equal logic hold that devices made according to the Wellington patent and other prior patents also infringe and since these patents are earlier the claims of the Bettis patent if so interpreted are invalid under the old rule "that which infringes, if later, anticipates if earlier."

Peters v. Active Mfg. Co., (1889) 129 U. S. 530,
32 L. Ed. 738, 741;

Grant v. Walter, (1893) 148 U. S. 547, 553, 37 L.
Ed. 552, 556.

POINT X.

**Our Client's Rights Should Not Be Prejudiced by
Matter Not Before This Court.**

Appellant's counsel attempts to lay great stress on alleged findings in the court below in another case as to the infringement of the Bettis patent by a ring identical in

construction with the Bettis ring. We regard this attempt to influence this court as highly objectionable since this other case is not before the court, the decision therein is based upon an entirely different state of facts, and we are not bound in this case by admissions or errors of counsel in another case. We are entitled to have this case decided on its merits and the attempt to inject into this case the alleged findings of the Honorable District Judge in another case is in our opinion quite unwarranted.

CONCLUSION.

- (a) The Bettis patent is in our opinion clearly invalid.
- (b) The Bettis patent is not infringed by our client's device.
- (c) We will be entirely satisfied if the decision in the court below is sustained and it is held that we do not infringe and the validity of the Bettis patent is not decided, since our client's rights are thereby fully protected, but we consider it our duty to bring the obvious invalidity of the Bettis patent to the court's attention so that the court may, if it wishes, terminate litigation thereunder.

Judgment for the appellee is earnestly prayed.

Dated at Los Angeles, California, this ^{10th}.....day of May, 1930.

Respectfully submitted,

FORD W. HARRIS,

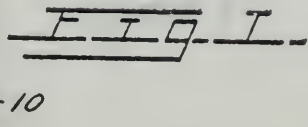
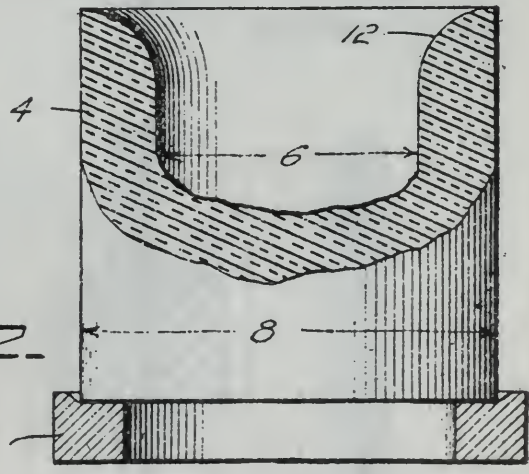
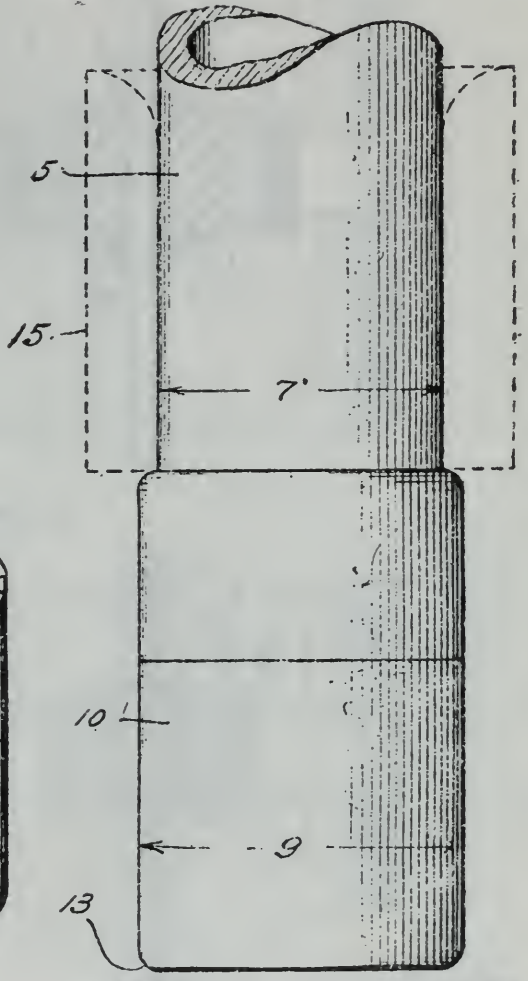
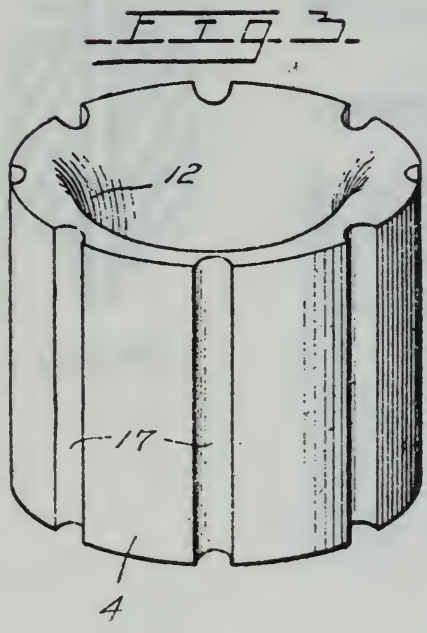
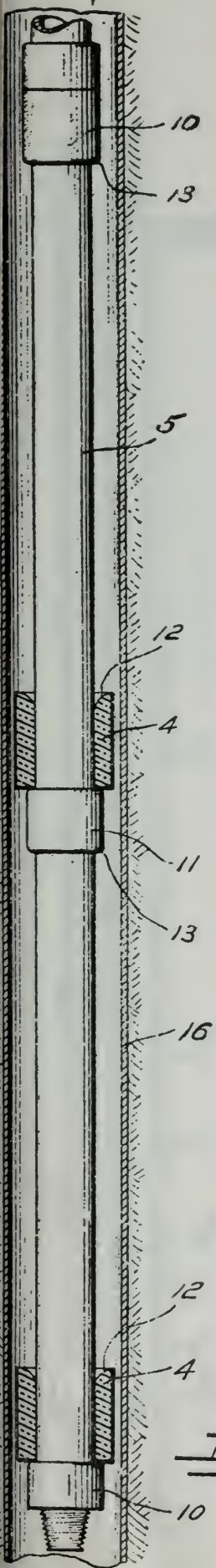
HERBERT A. HUEBNER,

Counsel for Defendant-Appellee, California Manufacturing & Engineering Company.

W. I. BETTIS ET AL

WELL CASING PROTECTOR

Filed Jan, 5, 1925



Inventors;
 William I. Bettis and
 Leroy H. Perry,

per *Arthur J. Farnsworth*
 Attorney.

424,964.

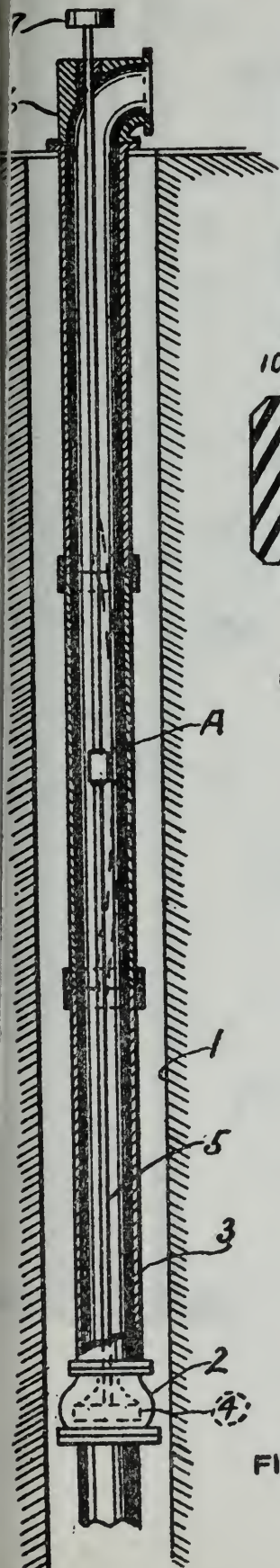


FIGURE 1

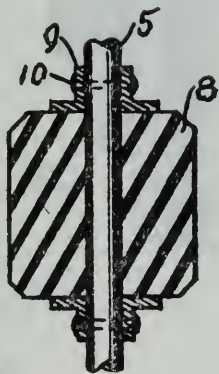


FIGURE 5

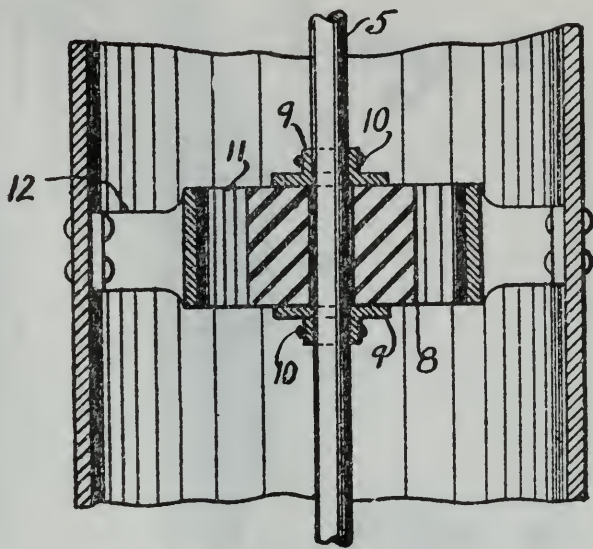


FIGURE 3

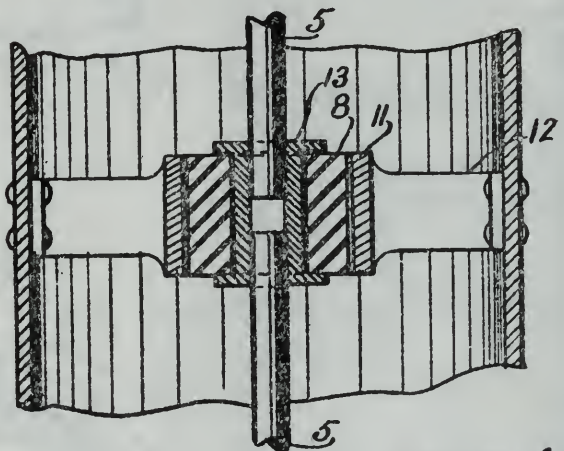
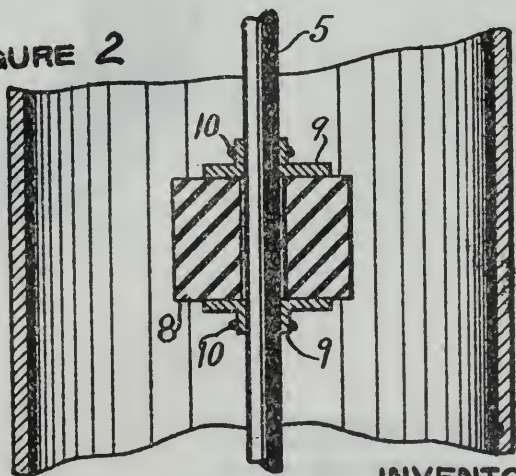


FIGURE 4

FIGURE 2



INVENTORS

Arthur W. Wellington

Arthur F. Ryan

BY John A. Knaismith.
ATTORNEY

Fig. 1.

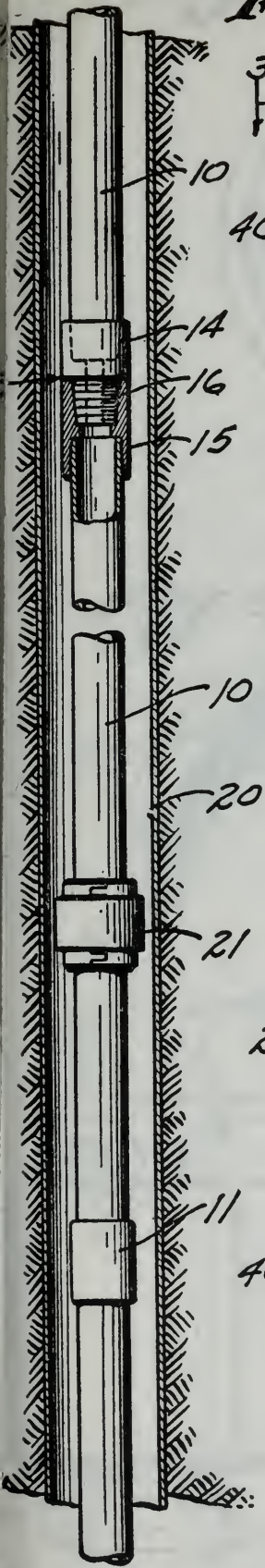


Fig. 2.

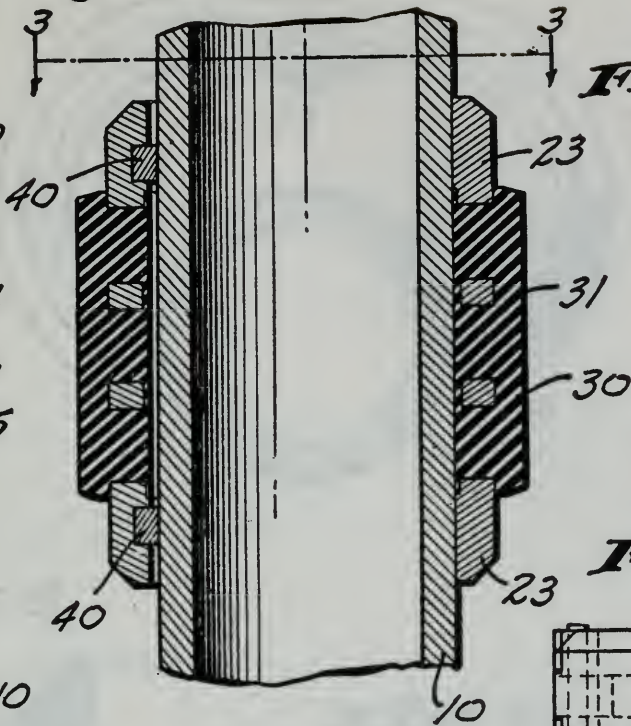


Fig. 4.

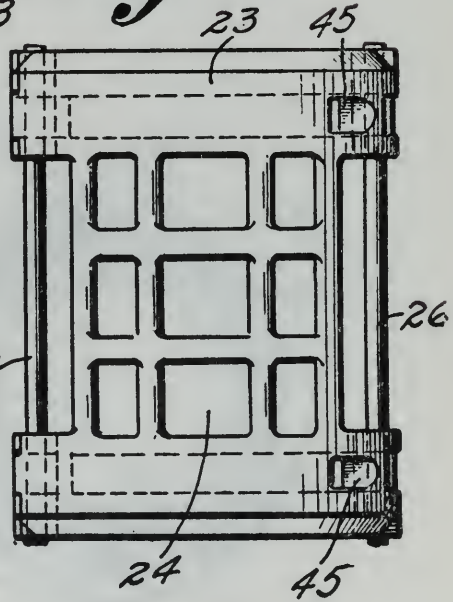
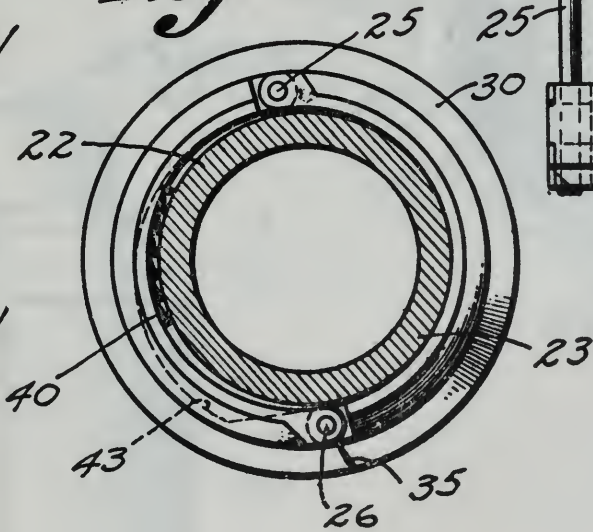


Fig. 3.



- PROTECTOR -
manufactured by
California Mfg. & Eng. Co.,
submitted in answer
to plaintiff's interrogatories.
2 Sheets - Sheet No. 1

Fig. 5.

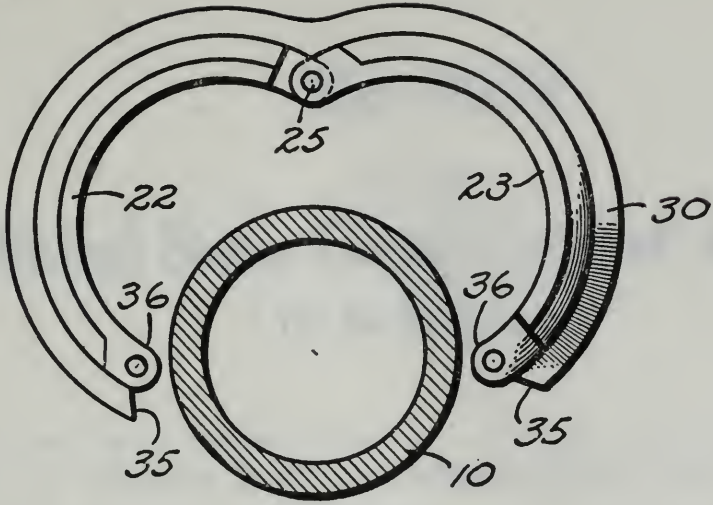


Fig. 8.

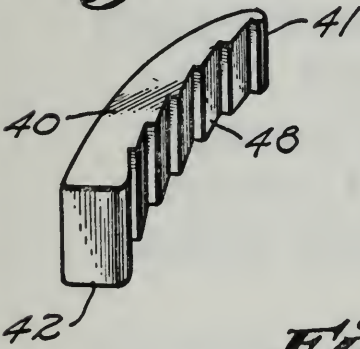


Fig. 7.

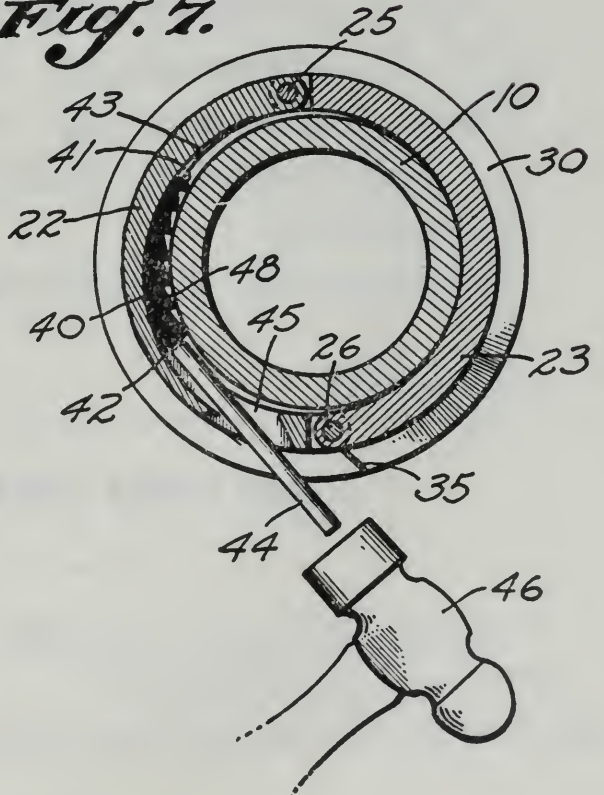
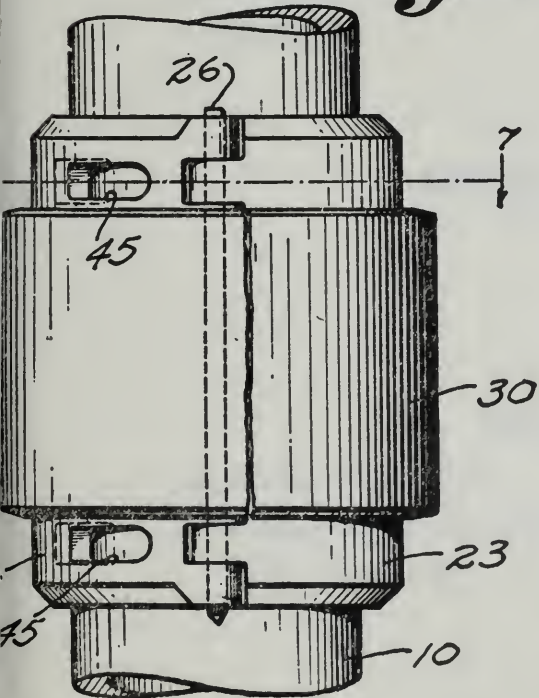


Fig. 6.



- PROTECTOR -
manufactured by
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to plaintiff's interrogatories.
2 Sheets - Sheet No. 2

